

REMARKS

Claims 1-26 are all the claims pending in the application.

Support for new claims 23-26 may be found in the specification as originally filed, for example, at pages 25 and 27.

I. The Obviousness-Type Double Patenting Rejection

Claims 1, 3, 8 and 14-15 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 6,159,656.

While Applicants respectfully submit that the present invention is not obvious over the claims of U.S. Patent 6,159,656, to expedite allowance of the present Application, Applicants are submitting herewith a terminal disclaimer to obviate the obviousness-type double patenting rejection over claims 1-16 of U.S. Patent No. 6,159,656.

For the above reasons, it is requested that the obviousness-type double patenting rejection over U.S. Patent No. 6,159,656 be reconsidered and withdrawn.

II. The Rejections Based on Suwa (EP 789,278)

Claims 1-15 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Suwa (EP 789,278).

Claims 16-22 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Suwa (EP 789,278) further in view of Niki (US 5,744,281).

The Examiner's statement of the rejections remains the same as stated in the Office Action dated November 14, 2000.

Additionally, in response to Applicants' arguments, the Examiner states that she has reviewed the comparative data presented in Applicants' specification, but does not find it persuasive. The Examiner notes that Applicants compare a surfactant outside of the scope of the claims (polyoxyethylene nonyl phenyl ether) with a surfactant within the scope of the claims (Megafac R08). The Examiner concludes that such a comparison "fails to compare the closest prior art." The Examiner indicates that "[a] more convincing comparison would be to compare polyoxyethylene nonyl phenyl ether with a Megafac surfactant which is similar to those disclosed in the prior art (i.e., Megafac 171 or Megafac 173) rather than comparing to a surfactant such as Megafac R08 which contains both silicon and fluorine."

Applicants respectfully submit that the present invention is not obvious over the teachings of Suwa, alone or further in view of the teachings of Niki, and request that the Examiner reconsider and withdraw this rejection in view of the following remarks.

Applicants' position concerning the disclosures of the cited references remains as stated in the Request for Reconsideration filed March 14, 2001. Additionally, filed concurrently herewith is a unexecuted Declaration under 37

C.F.R. §1.132. An executed version of the Declaration will be filed in due course to complete the record.

As to the use of the photosensitive resin composition containing the claimed surfactant, the 132 Declaration shows the results of experiments with the use of a surfactant, W-5 (Megafac F171), which is within the scope of the present invention among the surfactants described in Suwa, compared with the use of a surfactant, W-4 (polyoxyethylene nonyl phenyl ether), which is outside of the scope of the present invention. Comparing Example a and Comparative Example a', Table A' of the 132 Declaration, when the surfactant within the scope of the present invention is used, unexpected and excellent effects in the residual film rate and profile are obtained. However, when Surfactant W-4 as described in Suwa is used (comparative), the improvements in the residual film rate and profile are not obtained.

Additionally, comparing Example b and Comparative Example b', both containing Polymer D, when the surfactant (Surfactant W-5) of the present invention is used, unexpected and excellent effects in the residual film rate and profile are obtained. However, when Surfactant W-4 described and used in Suwa is used (comparative), the improvements in the residual film rate and profile are not obtained.

As to the use of the photosensitive resin composition containing the claimed solvent, the Declaration shows the results of experiments with the use of a

photosensitive resin composition prepared by using the weight ratio (S-3/S-6) of the solvent described in Suwa and a photosensitive resin composition prepared with a weight ratio (S-3/S-6) of the solvent within the scope of the claimed invention. When the solvent ratio within the scope of the present invention is selectively used, unexpected and excellent effects in term of the Development Defects-I and Development Defects-II are obtained. However, when a solvent ratio outside of the scope of the present invention is used, the excellent effects in the Development Defects-I and Development Defects-II are not be obtained.

Additionally, as seen from the comparison between Example c and Comparative Example c'-3, prepared by using the solvent described in Niki, the unexpected and excellent effects are not obtained with the photoresist resin composition representative of Niki.

As to new claims 23-26, the alicyclic polymers disclosed in Suwa all appear to have their alicyclic groups in the polymeric chain. The repeating units of formula (b-1) to (b-8) contain alicyclic groups that are pendant moieties.

For the above reasons, it is respectfully submitted that the subject matter of claims 1-22 is neither taught by nor made obvious from the disclosures of Suwa or Niki et al, either alone or in combination, and it is requested that the rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

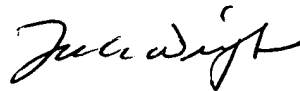
III. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the obviousness-type double patenting rejection and the rejections under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 09/295,329

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 23-26 are added as new claims.